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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,088	10/24/2003	Mark G. Fontenot	4012.13	8477
23308	7590	11/28/2007	EXAMINER	
PETERS VERNY, L.L.P. 425 SHERMAN AVENUE SUITE 230 PALO ALTO, CA 94306			ROBERTS, LEZAH	
ART UNIT		PAPER NUMBER		
1614				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/693,088	FONTENOT, MARK G.
Examiner	Art Unit	
Lezah W. Roberts	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on October 12, 2007.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-6, 14-18 and 21-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-6, 14-18 and 21-24 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_ .  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_ .

## DETAILED ACTION

This Office Action is in response to the Request for Continued Examination filed October 12, 2007. All previous rejections have been withdrawn unless stated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claims***

#### **Claim Rejections - 35 USC § 112 – New Matter (New Rejection)**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite the limitation "said primer solution being configured to synergistically enhance performance of a tooth whitening...". Although Applicant has defined synergistically, they make no other reference to a synergistic effect any where else in the specification. Furthermore in regards to the primer solution synergistically affecting the whitening composition, the specification discloses enhancing the effects of the whitening compositions, not "synergistically enhancing" the compositions.

**Claim Rejections - 35 USC § 112 – Indefiniteness (New Rejection)**

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 recites the limitation "The kit of Claim" in the first line. There is insufficient antecedent basis for this limitation in the claim because the claim does not recite from which claim the instant claim depends.

**Claim Rejections - 35 USC § 102 – Anticipation (Previous Rejection)**

Claims 21-22 were rejected under 35 U.S.C. 102(b) as being anticipated by Ambuter et al. (US 5,997,764). This rejection is maintained.

**Applicant's Arguments**

Applicant argues the claims have been amended to recite "said primer solution being configured to synergistically enhance performance of a tooth whitening composition applied to said tooth surface after application of said primer solution". These limitations do not appear to be taught in Ambuter. This argument is not persuasive.

**Examiner's Response**

The claims recite the primer solution comprises between 0.1 and 5 weight percent of the total composition and has a pH between 8.5 to about 13. The reference recites the pH of the compositions is above 10 and hypochlorite ranges from 0.1% to 50%. Therefore the composition of the reference should inherently have the same

synergistic properties as the compositions of the instant claims, since the compositions of the reference are substantially the same, comprising hypochlorite at substantially the same concentrations and the same pH, as the compositions of the instant claims.

**Claim Rejections - 35 USC § 103 – Obviousness (Previous Rejections)**

1) Claims 1-6 and 14-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Howes (US 2002/0098246). The rejection is maintained and withdrawn in regards to claim 16.

**Applicant's Arguments**

Applicant argues the amendments of claim 1 overcomes the rejection because it specifically recites "said tooth whitening compositions having been added to said primer solution after said primer solution is applied to said tooth surface". These limitations do not appear in Howes. Further, the Examiner has not shown that the pH is recognized as a result-effective variable, i.e., a variable which achieves a recognized result and therefore Applicant requests that the Examiner provide evidence that pH was recognized as a result effective variable for the desired result of tooth whitening at the time the application was filed or withdraw the rejection. Regarding claim 14, Howes does not appear to disclose a sequence of applying the compositions nor does the reference disclose instructions. In regards to claim 16, the reference has a different intended use and as such the instant claims describe a specific physical characteristic of the "instructions". These arguments are not persuasive.

**Examiner's Response**

The claims recite a composition for whitening teeth and not a method of applying a tooth whitening composition. Therefore the limitation of when each component is applied to the teeth does not carry weight in determining patentability because the compositions of the reference are substantially the same, comprising a peroxide solution and a hypochlorite solution, as the compositions of the instant claims. In regards to the pH, the Examiner has previously cited Wegner (US 2003/0151024, Priority Date 2/11/2002, Filing Date 2/6/2003), which discloses hypochlorite is very alkaline. It may be concluded a solution comprising hypochlorite as the only constituent would have a pH of hypochlorite. Furthermore the reference also discloses usually bleaching speed is increased at the expense of increased decomposition rate. Bleaching speed and decomposition rate usually increase as the pH increases. Therefore pH is a result effective variable and it would be obvious to optimize pH to obtain optimal whitening results. In regards to the instructions, as discussed above the claims recite a composition. The instructions disclose how to use the compositions but do not alter the function of the compositions. USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004). As disclosed by other recited prior art, peroxide and hypochlorite have been disclosed to whiten teeth and therefore the use of the compositions is obvious for teeth whitening.

2) Claims 1-4, 6 and 14-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over van den Bosch (US 6,017,515). The rejection is maintained and further applied to claims 23-24.

*Applicant's Arguments*

Applicant argues van den Bosch does not appear to teach separate compositions and instructions describing application of said primer-whitener solution to said tooth prior to application of said peroxide solution to said tooth or said tooth whitening as discussed above. Furthermore the Examiner has not shown that the pH is recognized as a result-effective variable and, thus optimization of pH within the recited range has not properly been shown to be obvious. These arguments are not persuasive.

*Examiner's Response*

Van den Bosch teaches two separate compositions a) which comprises sodium hypochlorite and b) which comprises sodium perborate. As discussed above the claims recite a composition and the order of applying the two compositions to the teeth carry no weight when determining patentability. Also see above subsection 1 in regards to the pH of the compositions. The reference discloses applying the compositions with a cap, which may also be considered a type of tray, encompassing claim 23.

3) Claims 1-6, 14-17 and 21-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Jung (US 2006/0060819). The rejection is maintained and further applied to claims 23-24.

*Applicant's Arguments*

Applicant argues Jung does not appear to teach separate solutions and instructions relating to timing of solution application as recited in Claim 1. Jung also does not appear to disclose instructions describing application of said primer-whitener solution to said tooth prior to application of said peroxide solution to said tooth or said tooth whitening as discussed above. Also the Examiner has not shown that the pH is recognized as a result-effective variable and, thus, optimization of pH within the recited range has not properly been shown to be obvious. These arguments are not persuasive.

Examiner's Response

Jung teaches separate solutions when it discloses a first paste comprising hydrogen peroxide and a second paste comprising hypochlorite. It also discloses the dentifrices may be liquid dentifrices. See subsection 1 in regards to the instructions and pH optimization. In regards to claims 23-24, the compositions are dentifrices and therefore it may be concluded they are applied by a brush.

Claims 1-6, 14-18 and 21-24 are rejected.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lezah W. Roberts whose telephone number is 571-272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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